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Mailed: 7-20-07
In re application of :
TANAGLIA :
Serial No. 10/810,695 :
Filed: March 29, 2004 :
For: ELASTOMERIC COMPOSITION FOR THE INSULATION OF ELECTRIC CABLES :
DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 for entry of the amendment filed February 16, 2007.

On April 19, 2007, an office action was mailed containing a restriction requirement and an election by original presentation. The examiner stated that claims 1-19 were directed to an invention that is independent or distinct from the invention originally claimed. The examiner withdrew claims 1-19 as being directed to a non-elected invention.

On May 10, 2007 the instant petition under 37 CFR 1.181 was timely filed to formally request that the examiner enter the amendment filed February 16, 2007. This petition will be treated as a petition to withdraw the restriction requirement held by the examiner in the April 19, 2007 office action.

DECISION

In the present application, the examiner stated that amended claims 1-19 filed February 16, 2007 are directed to an invention that is independent or distinct from the invention originally claimed. The examiner grouped the amended claims into two groups and alleged that each of the two groups and the already examined claims are related as mutually exclusive species in an intermediate-final product relationship. Claims 1-19, all pending claims, were then withdrawn from consideration as being directed to non-elected inventions.

Petitioner argues that the amended claims fall within the originally elected invention. An analysis of the claims indicates that the originally filed claims are directed to an "elastomeric blend...comprising one or more polymers". Note that the open claim language indicates that other ingredients may be present. The specification at page 5, lines 12 ff clearly indicates that the elastomeric blend also comprises the ingredients (mineral filler etc.) recited in the amended claims presented February 16, 2007. Thus, the addition of these ingredients to e.g. claim 1 does not create an invention that is independent or distinct from the invention originally claimed.

Petitioner is correct. The examiner has the burden of showing that the inventions are in fact distinct but in the instant case, such a showing has not been made.

Additionally, the examiner has not established that any serious burden exists to examine all of the claims as required by MPEP Section 803.

Accordingly, the restriction requirement as set forth in the office action of April 19, 2007 is improper and should be withdrawn. The instant petition is **GRANTED**. The examiner is directed to withdraw the requirement and prepare a new office action.

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